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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,821	12/21/2000	Daniel C. Carter	P06652US01/BAS	6567

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EXAMINER
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LIU, SAMUEL W

ART UNIT	PAPER NUMBER
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1656

MAIL DATE	DELIVERY MODE
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10/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/740,821

**Applicant(s)**

CARTER, DANIEL C.

**Examiner**

SAMUEL LIU

**Art Unit**

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50,52-57 and 59-61 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50,52-57 and 59-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## **DTAILED ACTION**

### *Status of claims*

Claims 50, 52-57 and 59-61 are pending.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 9/16/09 has been entered.

The amendment filed 9/16/09 which adds claims 59-61, cancels claim 58, and amends claims 50 and 54 has been entered. Claims 1-49 and 51 were cancelled by the amendment filed 10/31/07. Claims 59-61 are drawn to the examined invention. Claims 50, 52-57 and 59-61 are under examination. The applicant's request filed 9/16/09 for extension of time of three months has been entered.

### *Withdrawal of claim rejections*

The 112/1 (new matter) rejection of claims 50 and 52-58 is withdrawn in light of the amendment of claims 50, 54, and 57.

### *New-objection to the specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, i.e., "cleansing agent" set forth in claims 50, 54 and 57. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Corresponding correction is required.

### *New-Rejections - 35 USC § 112, first paragraph*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50, 52-57, and 59-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement; this is a new matter rejection. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of “an amount sufficient to impart a cleansing effect”, which as amended into the claims on 9/16/09, is not supported in the specification as originally filed. Applicant can either cancel the new matter or point out specification support for the phrase in the specification as originally filed.

The response filed 5/26/09 asserts that the amendment is supported by voluminous evidence (p.2, 2<sup>nd</sup> paragraph). No where in the specification shows said "support". In the absence of factual indicia indicating that the specification adequately described the above-mentioned phrase (as a new matter) based on the disclosure as originally filed, the 112/1 rejection above is deemed proper and stands.

***Maintained- Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 50, 52, and remain and claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50 recites "... and a cleansing agent, vehicle, carrier or excipient"; the recitation are unclear whether or not vehicle, carrier or excipient is the cleansing agent, and whether or not the "cleansing agent", or "vehicle", or "carrier" or "excipient" is parallel from one another. Also, metes and bounds of the phrase "cleansing effect" are unclear because the specification does not define/describe this phrase. Claims 52, 53 and 59 which depend from claim 50 are also rejected.

\* Examiner remark: neither the response filed 9/16/09 nor the response filed 5/26/09 particularly argues the above 112/2 rejection.

***Maintained-Claim Rejections - 35 USC §102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50, 52, 54, 55, 57, and 59-61 are rejected under 35 U.S.C. 102(b) as anticipated by Mausner, J. (US Pat. No. 5254331; previously cited 2/8/2005 document A on Form PTO-892) as is evidenced by Cosmetics-INFO (2007, updated; previously cited) "*Steareth-21*", [http://www.cosmeticsinfo.org/ingredient-details.php?ingredient\\_id=1650](http://www.cosmeticsinfo.org/ingredient-details.php?ingredient_id=1650), pages 1-2), Dictionary (2007, updated; previously cited) "*Soap*", <http://www.thefreedictionary.com/soap>, page 1), and Borgarello et al. (US Pat. No. 4942179).

In patent claim 6 and Table 1, Mausner teaches a skin cream composition comprising human serum albumin (item *i* at col.16, line 19), and steareth-21 which is a surfactant and

cleansing agent for cosmetic use (as is evidenced by “Cosmetic-INF” reference set forth at page 7 of the Office action mailed 1/11/06). The cleansing agent “steareth-21” accounts for about 1.3-1.7% of the composition. Water or glycogen disclosed in Table 1 and the patent claim 6 are considered to be equivalent to instant “carrier”. Since “soap” is a cleansing agent (as is evidenced by the reference “Dictionary” set forth at page 7 of the Office action mailed 1/11/06), and since patent claim 6 teaches that all components including cleansing agent “steareth-21” is dispersed in the water, said “steareth-21” is considered to be a liquid soap. This teaches instant claims 50, 54, and 57.

Mausner teaches that the protein complex comprises about 28% serum protein (col. 7, lines 2 and 3), wherein the protein complex comprises ~6.9% of the skin cream composition (col.7, lines 8-10); thus, the human serum albumin is 1.9% (calculation:  $28\% \times 6.9\% = 1.9\%$ ) of said composition. 1.9% is 1.9 g/100g, approximately equivalent to 1.9g/100 ml, i.e., 19 mg/ml. The ratio of the serum albumin (1.9 %) to the cleansing agent (1.3% -1.7%, see above) is about 1.1 to 1.5. Given all albumin is dissolved in the cleansing agent (note that the cleansing agent “steareth-21” per se is a surfactant, see above discussion) which is considered to be the "soap", then, in term of the “soap”, the serum albumin concentration is about 1.1-1.5 mg/ml of said “soap”. This inherently teaches claims 52 and 55.

Because the “steareth-21 is a surfactant which is commonly used as an excipient for formulating cosmetic composition as is evidenced by abstract of Borgarello et al., claims 59-61 are rejected.

*The applicant's response to the 102 rejection*

The response filed 9/16/09 argues that the prior art teaches away the instant claims because the prior art neither teach cleansing agent nor maintaining any cleansing agent in an amount sufficient to impart a “cleansing effect” (p.1, 2<sup>nd</sup> paragraph, the response). Thus, the response requests withdrawal of the rejection.

The applicant’s arguments are found unpersuasive because the prior art has taught “steareth-21” which is cleansing agent and is a component of the “skin cream composition” comprising human serum albumin. Here, the cleansing agent should have instant “cleansing effect”. This is due to the fact that identical components of a composition cannot have mutually exclusive properties, i.e., a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical agent, the properties applicant claims (“cleansing effect”) are necessarily present. See MPEP 2112.01. Since the office does not have a laboratory to test the cleansing effect of steareth-21 in said composition, it is applicant’s burden to show that the cleansing agent steareth-21 does not have the effect thereof. In view of these, the above 102 rejection is deemed proper and stands.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Liu whose telephone number is (571)272-0949. The examiner can normally be reached on Monday-Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew Wang, can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000

/Samuel Wei Liu/

Patent Examiner, Art Unit 1656

/ANAND U DESAI/

Primary Examiner, Art Unit 1656

October 23, 2009